

Remarks

Claim Status:

Claims 40, 41 and 52-63 are pending. Claims 30, 36-39 and 42-51 are canceled without prejudice and to reduce issues for this amendment, and appeal, if needed. We expressly reserve the right to file one or more continuing application targeting the subject matter of the canceled claims.

Claim 40 is amended without prejudice

Dependent claims 56-62 are newly presented for consideration.

New Abstract:

A new abstract is provided to even more closely conform to the remaining independent claim, claim 40.

Formal Rejections:

Claims 40, 41 and 52-55 are rejected as failing to comply with the written description requirement. We respectfully traverse these rejections.

In particular, it appears that the term “active” is questioned. The Office Action suggests that a definition is not provided for the term. See the Office Action, page 7, lines 17-21. We disagree.

For example, the Specification provides a definition as follows on pages 11, lines 25-29.

Wherever the database is located, the database can have only entries for songs included in the play list, or songs in the play list are highlighted as active. The latter means only the active entries are changed when the play list is updated, whereas the former means the database entries for newly added songs have to be added and database entries for songs in the database not included in the new play list have to be deleted.

Thus, in the context of claim 40, the term “active” means, e.g., an indication or other designation showing which entries are to be changes when a playlist is to be updated. The term “highlighted” is added to claim 40 without prejudice to even better conform to the above cited passage.

Withdrawal of these rejections is requested.

Drawings & Specification Objections:

The drawings and specification are objected to variously for needing to show each features of the claims, and for introducing new subject matter.

We traverse these rejections and ask for reconsideration in view of the above comments (under “Formal Rejections”).

We also note that claim 40 has been amended; and ask for consideration of the new claim language in view of these objections.

Reconsideration is requested.

Statutory Subject Matter:

Claims 40, 41 and 52-55 are rejected as being directed to non-statutory subject matter. We respectfully traverse these rejections. Nevertheless, and without conceding the merits of these rejections, claim 40 is amended to recite “*using a programmed electronic processor*” to perform an act of deriving.

Withdrawal of these rejections is requested.

Art-Based Rejections:

Claims 40, 41 and 52-55 stand rejected as being unpatentable over US Published Application No. US 2003-0027010 A1 (hereafter referred to as “Schmelzer”) in view of U.S. Published Application No. US 2002-0168082 A1 (hereafter referred to as “Razdan”).

We traverse these rejections.

Claim 40 in view of Schmelzer and Razdan

We only see direct comments regarding claim 40 on page 13, line 17 – page 14, line 11, of the Office Action.

There, the Office Action suggests that no patentable weight should be given to the phrase “subject to updates.” We disagree.

First, we note that this is a mere conclusory statement, which cuts against the requirements of KSR and other legal precedent. Indeed, the key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reasons why the claimed invention would have been obvious. The Supreme Court in KSR International Co. v.

Teleflex Inc., 82 USPQ2d 1385, 1396 (2007), noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that “rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” In re Kahn, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also KSR, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval).

Second, the questioned claim passage is amended to even more clearly show the intent of these features as part of the claim. These features now recites: “*identifying a subset of the list of content items highlighted as active content items, the subset comprising content items subject to updates*”.

Third, the Office Action fails to identify a specific prior art section that would render obvious these features. Clarification is requested so that these features can be specifically addressed on appeal.

Conclusion:

We await clarification. In the meantime, the Examiner is invited to contact the undersigned with any questions.

Date: February 18, 2010

Respectfully submitted,

DIGIMARC CORPORATION

Customer No. 23735

Phone: 503-469-4685

By: /Steven W. Stewart, Reg. No. 45,133/

FAX: 503-469-4777

Steven W. Stewart

Registration No. 45,133